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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,656	06/29/2001	Alan C. Berkema	10016784-1	9732

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,656

Applicant(s)

BERKEMA ET AL.

Examiner

Peter Poltorak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/24/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-39 have been examined.

Oath/Declaration

2. The address of one of the inventor (Todd Fishcher's) is missing. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Abstract

3. The last abstract line: "F:\DATA\WP60\3417\65544\10016784.doc" is not understood.

Claim Objections

4. Claims 24-25 and 28-30 are objected to because of the following informalities: the referenced claim numbers 232 and 226 are not found in the application. For the purpose of further examination it is assumed that claim 232 should be numbered 23 and 226 should be numbered 26.
5. Claims 25 and 29-30 are objected to by virtue of their dependence
Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
7. In claims 1, 21 and 23 "the computer" lacks antecedent basis.
8. In claims 26 and 37 "the portable wireless device" lacks antecedent basis.
9. Claim 21 recites a limitation that calls for the print device to print the reference. The other claim limitations as well as the specification suggest that the reference is for retrieving a content and that the content is printed as opposed to the reference. Since no discussion is present about printing the reference in the specification the examiner believes that claim 21 refers to printing the content and as a result it is treated as such.
10. Claims 2-20, 22, 24-25, 27-36 and 38-39 are rejected by virtue of their dependence. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 5-6, 13-19, 23-31 and 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by *Larsson et al.* (*International Publication No. WO 0142894*).
12. As per claims 1 and 23 and 26 *Larsson et al.* teach a print device communication device (300b) receiving a document address from the cellular telephone and transmitting the document address and the printer specification to the information service provider (*pg. 13, lines 34-35*), information service provider (200) which is a server for serving the documents and provides access to documents or other browsable information (*pg. 13 lines 11-15*), and a print service device (200) implemented in the information service provider and handling the request of a document to be printed (*pg. 13 lines 15-22*). Afterwards the retrieved document is sent to the target printer (*pg. 17 lines 27-31*).
13. As per claim 2 *Larsson et al.* teach that the information service provider is an Internet portal (*pg. 13 lines 10-11*).
14. As per claim 3 *Larsson et al.* teach the content locator comprising URL on *pg. 24 lines 25-30*.
15. As per claim 5 *Larsson et al.* teach providing the print service (print service device) with printer's specification (*col. 16 lines 7-9*) upon which the document is retrieved (*pg. 16 lines 13-20*) and converted using a portion of the printer specification containing data for selecting an appropriate device driver to determine what device driver to use for creating the print file (*pg. 17 lines 11-15*).

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16. As per claims 13-16 *Larsson et al.* teach wirelessly communicating a discovery signal to a print device and receipt of a responsive signal identifying the print device within the reach of the telephone (*pg. 20 line 15- pg. 21 line 11*).
17. As per claims 17-19 *Larsson et al.* teach a communication device transmitting the document address and the printer specification to the information service provider. The printer specification comprises data regarding the transport route for a print file that is to be printed (*pg. 13 line 35 - pg. 14 line 4*).
18. As per claim 23 *Larsson et al.* teach communicating a reference to a print service wirelessly, the reference identifying a location at which a print content is located on a network, wherein the reference causes the print service to retrieve the print content (*pg. 21 lines 1-11*).
19. Limitations of claims 24 and 25 are taught on pg. 21 lines 12-34.
20. Claims 23 and 26 are substantially equivalent to claim 1; therefore claims 23 and 26 are similarly rejected.
21. Pg. 12 line 30 – pg. 13 line 6 address claims 27-29.
22. The limitations of claims 30-31 are taught on pg. 20 line 15 - 21 line 11.
23. As per claim 37 *Larsson et al.* teach a second communication interface (*short-range link interface*) to enable wireless communication between the portable wireless device and a print device and a first communication interface (*wireless telephone network interface*) to communicate a reference that identifies the location of a print content to the print service (*pg. 20 line 25 – pg. 26 line 11*). Furthermore, *Larsson et*

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network interface) to communicate a reference that identifies the location of a print content to the print service (pg. 20 line 25 – pg. 26 line 11). Furthermore, Larsson et al. teach the print service to retrieve the print content and to transmit it to the portable wireless device (pg. 14 lines 5-7 and 19-24).

24. Claim 38 is taught on pg. 21 lines 12-27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Larsson et al. (International Publication No. WO 0142894) in view of Saylor et al. (U.S. Patent No. 6501832)

26. *Larsson et al.* teach the reference as discussed above. *Larsson et al.* do not teach adding billing information to the reference. *Saylor et al.* teach to add billing information to the reference (*Saylor et al.*, col. 31 lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to adding billing information to the reference as taught by *Saylor et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to properly charge users for accessing the per fee content (*Saylor et al.*, col. 39 lines 44-49 and col. 27 lines 42-46).

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As per claim 7-8 *Larsson et al.* teach the computer to download the reference from the network in response to a user input; *Larsson et al.* teach browsing the web and linked WAP-pages by selecting links with the use of the computer (*pg. 20 lines 1-25*). *Larsson et al.* do not explicitly teach the reference to be downloaded and converted before the computer communicates the reference to the print device.

Official Notice is taken that it is old and well-known practice to download and convert data before communicating the data to the print device. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to download and convert the reference before the computer communicates the reference to the print device. One of ordinary skill in the art would have been motivated to perform such a modification in order to speed up the printing process.

29. As per claim 21 Official Notice is taken that it is old and well-known practice to use the print format data instructing the print device to print the reference beginning on a new sheet (*form feed*). One of ordinary skill in art at the time of applicant's invention would employ the print format data instructing the print device to print the reference beginning on a new sheet in order to separate distinct content.

30. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Terrill et al.* (*U.S. Pub. No 20020188646*).

31. *Larsson et al.* teach the computer communicating with the print device as discussed above. *Larsson et al.* do not explicitly teach communicating a request for status information to the print device and receiving status information from the print device.

Terrill et al. teach communicating a request for status information to the print device and receiving status information from the print device (*Terrill et al. Abstract*). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a request for status information to the print device and to receive status information from the print device as taught by *Terrill et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to provide print monitoring capability (*Terrill et al., col. 2 lines 28-44*).

32. Claims 9-12 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Takahashi* (*U.S. Pub. No 20010016912*) and in further view of *Yoon et al.* (*U.S. Patent No. 6173407*).

33. As per claims 9-10, 12 and 32-33 *Larsson et al.* teach the computer communicating with the print device as discussed above. *Larsson et al.* do not explicitly teach the computer interface communicating a security access code (in response to a security challenge received from the print device) to the print device enabling usage of the print device. *Takahashi* teaches the computer interface communicating a security access code to the print device enabling usage of the print device [83]. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a security access code to the print device enabling usage of the print device as taught by *Takahashi*. One of ordinary skill in the art would have been motivated to perform such a modification in order to improve the print security function (*Takahashi, [05]*) and avoid waste printing (*Takahashi, [2] and [84]-[86]*).

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Since *Takahashi* teaches that the printing is not executed as long as a person with print authority is identified (*Takahashi [83]*) and thus the security challenge received from the print device is implicit.

34. As per claims 11 and 34 *Larsson et al.* teach the computer program product being sent to the printer causing the print device to access print content which is the Internet content as discussed above. *Larsson et al.* do not explicitly teach the computer interface communicating a security access code to the print device enabling access to the print content. *Yoon et al.* teach sending a security access code enabling access to the print content (*Internet content, Yoon et al., Abstract*). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send access code enabling access to the print content as taught by *Yoon et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to allow access to fee-based content and determine the charges for the content usage (*Yoon et al., col.1 lines 45-60*).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Signature

1/4/08
Date


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